

## REMARKS/ARGUMENTS

The present application has been carefully reviewed in light of the November 26, 2003 Office Action. In response to the Office Action, Applicant has amended independent claims 4, 7 and 9. Reexamination and reconsideration of the application, as amended, is respectfully requested.

### 35 U.S.C. §101 REJECTION

Claims 4-8 were rejected in the Office Action under §101 based upon the assertion that the claimed invention is directed to non-statutory subject matter. Applicant respectfully traverses this rejection and asserts that the invention is directed to functional matter falling within the scope of §101. The United States Supreme Court in its *Benson*, *Flook*, and *Diehr* decisions have elaborated on the use of the expansive term “any” in §101 as representing Congress’ intent not to place any restrictions on the subject matter for which a patent may be obtained beyond those specifically recited in §101 and other parts of Title 35. The Supreme Court in these decisions has explained that there are only three categories of subject matter for which one may not obtain patent protection namely “laws of nature, natural phenomena, and abstract ideas, such as pure mathematical algorithms and equations”. Applicant’s invention does not fall within these three categories and is in fact functional.

Many patents have been issued by the United States Patent and Trademark Office in which the inventive subject matter is printed matter or material which is functional with respect to the invention. Applicant’s invention falls within this category of inventions and thus is statutory subject matter.

Applicant’s assertion that the claims are directed to statutory subject matter is further supported by the pertinent case law.

For example, in In re Miller, 164 USPQ 46 (CCPA 1969), the Examiner and the Board asserted that printed matter on measuring cups or measuring spoons were given no patentable weight. However, the Court of Customs and Patent Appeals reversed these decisions and found that the printed matter of Miller's invention was functionally related to the volume measuring device.

The Federal Circuit in In re Gulack, 217 USPQ 401 (Fed. Cir. 1983), expounded upon the Miller decision. The sole difference between the appealed claims of the Gulack application and the Wittcoff reference resided in the content of the printed matter. In re Gulack, at 403. The Federal Circuit held that differences between the inventions and the prior art cited against it cannot be ignored merely because those differences reside in the content of the printed matter. The Federal Circuit stated that "under section 103, the Board cannot dissect a claim, excise the printed matter from it, and declare the remaining portion of the mutilated claim to be unpatentable. The claims must be read as a whole." The Federal Circuit further stated that "what is required is the existence of *differences* between the appealed claims and the prior art sufficient to establish patentability."

The Federal Circuit reversed the Board and the Examiner and held that there was a functional relationship between the printed matter and the substrate of the appealed claims, and that the relationship between the printed matter and the substrate differed from the relationship exhibited by the corresponding elements of the Wittcoff reference.

Similar to the In re Gulack case, the printed participating vendor web-site addresses and promotion discount indicia and promotion code is functionally related to the business card and cards and greeting cards which are the subject of Applicant's invention in that they encourage the retention of such cards and bridge the gap between the physical world and the electronic world by enticing potential consumers to visit the participating vendors web-sites to obtain such promotional discounts whereas the potential consumers might not otherwise visit the

participating vendors web-sites. Accordingly, Applicant respectfully submits that the rejection is mis-guided and should be withdrawn.

#### CLAIM REJECTION UNDER 35 U.S.C. §103

Claims 4-13 were rejected under 35 U.S.C. §103(a) as being obvious over Rodriguez et al., in view of King, and Rubstein et al.

To establish a *prima facie* case of obviousness, three basic criteria must be met. First, there must be some suggestion or motivation, either in the references themselves or in the knowledge generally available to one of ordinary skill in the art, to modify the reference or to combine reference teachings. Second, there must be a reasonable expectation of success. Finally, the prior art references must teach or suggest all the claim limitations. See MPEP §2143.

With reference to MPEP §2143.03, to establish *prima facie* obviousness of a claimed invention, all the claim limitations must be taught or suggested by the prior art. In re Royka, 18 USPQ 580 (CCPA 1974). All words in a claim must be considered in judging the patentability of that claim against the prior art. In re Wilson, 165 USPQ 494, 496 (CCPA 1970).

The present invention, as recited in the claims and described in the application, resides in providing a multi-purpose card, typically in the form of a business card or a greeting card. Aside from the typical printed matter on such cards, the present invention prints multiple participating vendor web-site addresses on the card. Vendor promotion discount indicia is also printed on the card. A promotion code is printed on the business card as well. A cardholder accesses a computer network to log onto the participating vendors web-site, using the vendors web-site address which is printed on the card and which is visually distinguishable by the cardholder. The promotional code is then entered at the appropriate time at the web-site and the cardholder is able to obtain the indicated promotional discount. The invention is intended to encourage

those receiving business and greeting cards to retain such cards as having value beyond the information printed thereon, such as the business information on the business card. The invention also encourages the cardholder to visit the participating vendors web-site addresses. There currently exist millions of web-sites. These web-sites can be expensive to set up and maintain. The purpose of these web-sites is to promote the business of the owner of the web-site. However, a common problem is that these web-sites are not visited to the extent that the owner of the web-site would like. In some instances, potential consumers might not even be aware of the vendor's web-site. Accordingly, potential consumers receiving a business card or the like are encouraged to visit the web-sites in order to receive the promotional discount printed on the card. This bridges the gap between the physical world in which paper and plastic-based cards are given and the electronic world which is accessed through the Internet.

Rodriguez et al. is directed to a system wherein physical or electronic objects are encoded with identifiers, which serve to trigger object appropriate responses from computer systems that encounter such objects. As shown in the flow chart and discussed in paragraphs 10 and 11, Rodriguez et al. supplement the textual information on a card, such as a business card, with steganographically-encoded multi-bit binary data as this does not significantly distract from the visual esthetics of the card yet can be used by an associated computer to initiate a link to an Internet site corresponding to the business card giver. As discussed in paragraphs 9-11, Rodriguez et al. preferably uses digital water marking which hides the information in document images, such as by printing very fine lines on a medium to slightly change the mediums apparent tint, while also conveying digital data, adjusting the contours of printed imagery to convey the digital data, or texturing the surface of the paper to convey optically-detectable binary data.

In contrast to the present invention, the steganographically-encoded multi-bit binary data is not visually distinguishable by a card holder. It is imperative in the present invention that the cardholder be

able to readily discern and read the web-site address, promotional discount indicia and promotion code in order to be encouraged to visit the participating vendors' web-site. In contrast, Rodriguez et al. hide such information which is only discernable to an electronic scanner coupled to a computer. Only after scanning the card, decoding the stego data and using the decoded stego data to direct the browser to the web-site is the Internet data displayed for viewing. Such a complicated and expensive method is contrary to the present invention and actually teaches away from the present invention.

With respect to the assertion in the Office Action that Rodriguez et al. also teaches "vendor promotion discount indicia" printed on the business card, a close review of Rodriguez et al. publication will reveal that this is simply not the case. Paragraph 19 of the Rodriguez et al. publication states that at the ultimate web-site, the user is presented with whatever information the business card giver chooses to provide, including biographical information, photos, promotional offers or advertisements relating to the card givers business. Such "promotional offers or advertisements" are not necessarily equivalent to "promotion discount indicia". Whereas in the present invention an actual discount is indicated, for example, 10% discount on shoes, buy one get one free, etc., the Rodriguez et al. patent could simply provide promotional advertising material in the form of an audio visual without any related discounts. Furthermore, such information is not printed on the card but rather found at the ultimate site.

The Office Action correctly stated that Rodriguez et al. does not teach multiple vendor web-site addresses printed on the card. Thus, the Office Action combined the teachings of King with Rodriguez et al. King is directed to a disposable cleaning device for cleaning particulate matter, such as lint, dandruff, string, hair, etc. from clothing. King discloses a protective cover which is generally rectangular and has two protective flaps which fold in towards one another to form a pad receiving area. Adhesive-backed leaves are affixed to the pad receiving area and the sheets are removable and when rubbed on clothing the adhesive acts to

adhere the particulate matter to the sheet. The cleaning device is sufficiently compact so as to be used in a promotional manner, as a business card and also to carry multiple advertising messages. It is contemplated by King that it be dispensed as part of a hotel room package together with shampoo and other toiletries, or alternatively purchased by a traveler or a consumer at a low cost.

On its face, the disposable cleaning device of King and the complex encoded physical object/computer system of Rodriguez are completely non-analogous to one another and are improperly combined in the rejection. It is not appropriate to use Applicants' disclosure of a unique combination of elements as a "shopping list" in order to assert that because the separate elements might be found elsewhere in various other apparatuses, the new combination is obvious. "That is not the proper test; rather, the critical inquiry is to whether there is something in the prior art as a whole to suggest the desirability, and thus the obviousness of making the combination." (Emphasis in original) In re Newell, 13 USPQ 2d 1248, 1250, *supra*, quoting from Fromsen v. Advance Offset Plate, 225 USPQ 26, 31 (Fed. Cir. 1985). When taken as whole, the King and Rodriguez et al. references have absolutely no suggestion of the desirability and thus the obviousness of making the combination of the references.

The mere fact that a prior art structure could be modified to produce the claimed invention would not have made the modification obvious unless the prior art suggested the desirability of the modification. In re Fritch, 23 USPQ 2d 1780 (Fed. Cir. 1992). Applicant believes that impermissible hindsight was used in reconstructing non-analogous references that should not have been combined in an attempt to reject the claims of the present application. As is well-known, hindsight is strictly forbidden, It is impermissible to use the claims as a framework from which to pick and choose among individual references to recreate the claimed invention. In re Fine, 5 USPQ 2d at 1600. It is also well-known that it is impermissible within the framework of 35 U.S.C. §103 to pick and choose from a reference only so much of it as will support a conclusion of obviousness to the exclusion of other parts necessary to a full

appreciation of what the reference fairly suggest to one skilled in the art. Bausch & Lomb v. Barnes-Hind/Hydrocurve, Inc., 230 USPQ 416 (Fed. Cir. 1986).

Notwithstanding the improper combination of the non-analogous references, King simply fails to teach what the Office Action purports. That is, there is absolutely no teaching, disclosure, or even inference that King includes multiple participating vendor web-site addresses, vendor promotion discount indicia, or a promotion code. Instead, in typical fashion of toiletries, bars of soap, shampoos, etc. offered free at hotels, King discloses that the offering company could utilize the cleaning device as an advertisement vehicle by placing the hotel's logo or trademark thereon. There is no mention of multiple participating vendor web-site addresses, promotion discount indicia, or promotion codes. Thus, King fails to overcome the shortcomings of Rodriguez et al. Therefore, the combination of Rodriguez et al. and King fail to render independent claims 4, 7 and 9 obvious and the rejection should be withdrawn. If an independent claim is not obvious under 35 U.S.C. §103, then any claim depending therefrom is non-obvious. MPEP §2143.03; In re Fine, 5 USPQ 2d 1596 (Fed. Cir. 1988).

The Office Action properly admitted that Rodriguez et al. does not teach promotion code printed on the card. Thus, the Office Action combined Rodriguez et al. with Rubstein et al. which teaches a unique game code assigned to digital files, such as animated greeting card digital files, for purposes of awarding a prize for a lottery, lucky draw, sweepstakes, contests, promotion and other games which would require some level or security control. Rubstein et al. is directed to on-line delivery of electronic files, and particularly to dynamically integrating information to construct the electronic files for on-line delivery (Paragraph 003). Rubstein et al. discussed the previous problems of when two or more executable digital files are integrated, they need to be recompiled to properly link the processes of the executable files. Rubstein et al. discussed that this causes unnecessary system load and consequently slow down in the system response. Thus, Rubstein et al. disclose a

system in which executable files may be dynamically integrated on-the-fly without going through compilation of the combined files. The assignee of the Rubstein et al. invention makes a wide selection of greeting cards for all occasions which can be purchased over the Internet and are embodied in a self-contained executable file which displays inappropriate animation that delivers the greeting. Rubstein et al., as discussed above, discussed the desirability of assigning a unique identification into the greeting card to control the number of times the file may be changed and also for purposes such as a contest, sweepstakes, etc.

Once again, the Rubstein et al. and Rodriguez et al. inventions are completely non-analogous to one another and have been improperly combined. Furthermore, Rubstein et al. does not discuss the use of paper or plastic-based business or greeting cards. Instead, Rubstein et al. is directed to the dynamic integration of electronic files. Moreover, Rubstein et al. does not teach of printing vendor promotion discount indicia on a business or greeting card for redemption at the respective web-site address. The vendor promotion discount indicia used in association with the present invention is an actual discount to be redeemed by visiting the web-site and making a purchase from the web-site or printing the discount for redemption at a physical store location. It is not directed to a contest, lucky draw, sweepstakes, or games which would require security control as taught in Rubstein et al. Thus, Applicant respectfully submits that Rubstein et al. and Rodriguez et al. have been improperly combined. Moreover, the combination of Rubstein et al. and Rodriguez et al. still do not arrive at the present invention as recited in the independent claims. Thus, Applicant respectfully submits that the rejection is improper and should be withdrawn.

The Office Action properly admitted that none of the references teach printing on the opposite side of the card, as recited in claims 6, 8, 11 and 13. The Office Action asserts that "it would be counterproductive to print everything on one side of the card". There is absolutely no basis for this assertion in any of the references forwarded by the Examiner. Moreover, in the present invention, there is a logical reason for printing on



the opposite side of the card. The multi-purpose card must serve as a business or greeting card. Thus, in a particularly preferred embodiment, the front face of the business card is in typical fashion, while the back face of the card is printed with the multiple participating vendor web-site addresses, vendor promotion discount indicia, and promotion code. Similarly, preferably such information is printed on a face of a greeting card which does not include the artwork or message of the greeting card. Thus, Applicant respectfully traverses this rejection as being baseless.

As discussed above, the present invention addresses the problems and concerns of business card retention and the visiting of web-site addresses of vendors. None of the cited references address the problem solved by the present invention. In the rare case where the prior art does not appreciate the existence of the problem solved by the invention, Applicant's recognition of the problem is, in itself, strong evidence of the non-obviousness of the invention. In re Nomya et al., 184 USPQ 607, 612,613 (CCPA 1975).

## CONCLUSION

In view of the foregoing amendments and remarks, Applicant respectfully asserts that claims 4-13 of the present application constitutes statutory subject matter and are not rendered obvious by the cited references. Accordingly, the present application is in condition for allowance, notice of which is hereby respectfully requested.

Respectfully submitted,

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A handwritten signature in black ink, appearing to read 'Aaron T. Borrowman', is written over a horizontal line. The signature is stylized with a large loop at the end.

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